

Withdrawal of Finality

Applicants note that the finality of the Office Action mailed September 29, 2003 has been removed.

Filing Date Correction

Applicants also note the Examiner's acknowledgement that June 25, 2001, as has been established in the record as the correct filing date. Also, this was confirmed by the granted petition to correct the filing date (filed January 31, 2002).

Further, Applicants agree that the filing date should have been corrected by the Initial Patent Examination Division a long time ago. Personal visits and telephone calls to this office have thus far failed to result in a changed filing date.

Restriction Requirement

In the outstanding Office Action, the Examiner maintained a Restriction Requirement that divided the application into two Groups:

Group I directed to the methods of claims 32-42, 44-48, 51, and 52; and

Group II, directed to the methods of claims 53-63.

The basis for maintaining the Restriction appears to be that the claims "were not originally presented and are drawn to different methods of use."

The traversal of this Restriction Requirement is maintained.

Applicants respectfully submit that the fact that claims 53-63 were not originally presented is not a valid reason, on its own, to withdraw the claims. MPEP § 821.03 indicates that the newly present claims must still be independent and distinct before restriction is proper.

As stated in the previous Response, in order to properly issue a Restriction Requirement, the burden is on the Examiner to show two criteria: (i) the Application claims independent or distinct inventions, as required by both § 121 and USPTO rules, and (ii) that examining all the claims inventions in a single application would constitute a serious burden. See MPEP § 803.

MPEP § 821.04, cited by the Examiner, includes a form paragraph that requires specific reasoning to be set forth as to why the newly submitted claims are directed to an invention that is independent or distinct from the invention originally claimed. Thus, as stated above, the fact that the claims were not “originally presented” is not a valid reason, on its own, to withdraw the claims.

Applicants maintain that in the instant case, there is no showing that the inventions are independent and distinct. Additionally, there is no indication in the Office Action that the inventions are each classified differently and would require an undue amount of additional searching. Further, there is no indication that any additional searching or consideration (if in fact there is any) would be undue. The pyrimidine compounds, which are central to the claimed methods, and believed to control classification, overlap. For example, Formula 4 is present in claim 32 (Part of Group I) and claim 53 (part of Group II). The Office Action provides no reasons or objective evidence on the record to substantiate either a separate classification, separate status in the art, or different field of search for the separate inventions.

In view of the above, the Examiner is respectfully requested to withdraw the Restriction Requirement. As stated in the previous Response, originally a four-way Restriction Requirement was made. In order to expedite the prosecution of the Application, Applicants cancelled the non-elected claims in the Amendment that followed.

Issues Under 35 U.S.C. § 103

Claims 32-35, 37, 40, 42, 48, 51 and 52 stand rejected under 35 U.S.C. § 103 as allegedly being obvious over Henrie, II et al., US 5,521,192 in view of Treybig et al., US 4,871,848. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are required.

The Federal Circuit has stated that “in holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill to select the references and combine them in a way that would produce the claimed invention.” See *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001).

Additionally, the references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion must be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In the present case, the references, when combined, do not suggest all of the claims limitations. ‘192 is applied as a primary reference. As stated in the office action, ‘192 fails to disclose or suggest the claimed methods of the present invention.

The secondary reference, '848, was cited due to its alleged disclosure that "several aromatic nitrogen-containing heterocycles, including pyrimidines (as a class)... are used in a composition to inhibit corrosion in [an] oil or gas well." See the Office Action at page 3.

The '848 patent attempts to address the problem of corrosion of metal tools and equipment associated with drilling and servicing oil and gas wells. See '848, col. 1, lines 23-27. The metal equipment corrosion inhibitor compositions of '848 form films on the metal surfaces of the equipment to protect the equipment. See col. 11, lines 7-10.

Thus, the '848 secondary reference fails to remedy the deficiencies of the primary reference in that it fails to disclose or suggest the methods of the present invention. That is, '848 fails to disclose or suggest the methods of reducing the oxidation rates in a petroleum composition.

Secondly, there is no suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill to select the references and combine them in the way suggested by the Office Action that would produce the claimed invention.

The teachings or suggestions, as well as expectation of success must come from the prior art, and not Applicants' disclosure. See *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). There is no suggestion or motivation to use the compositions of '192 as antioxidants. There is no suggestion or motivation to modify the compounds of '848 to arrive at the present invention. As an example, there is no suggestion that the R group hydrogen or hydrocarbyl in the '848 pyrimidine compounds for the hydroxyl of the present invention, particularly in view of the fact of no overlapping utility. Additionally, there is no motivation to modify the methods of '848 to arrive at the methods of the present invention.

At best, the Office Action outlines an “obvious to try” situation where the instant disclosure is used as a blueprint to find prior art corollaries for the claimed elements, and an attempt is made to piece together the elements of the prior art in an attempt to negate patentability. This method has repeatedly been frowned upon by the courts. For example, see *Sensonics, Inc. v. Aerosonic Corp.*, 38 U.S.P.Q.2d 1551, 1554 (Fed. Cir. 1996) (“an illogical and inappropriate process by which to determine patentability”).

Since there was no motivation to piece together the references to arrive at the present invention, and since the references, when pieced together fail to disclose or suggest all of the claim limitations, Applicants respectfully request that this rejection be withdrawn.

Claims 32, 35, 36, 38, 39, and 41 stand rejected under 35 U.S.C. § 103 as allegedly being obvious over LaMattina, US 4,554,276 in view of Treybig et al., US 4,871,848. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are required. The same issues discussed above are relevant to this rejection. ‘276 has deficiencies admitted in the Office Action. There is no motivation to combine ‘276 with the secondary reference (‘848, discussed in detail above). Additionally, the two references, when combined, fail to disclose or suggest the subject matter as claimed. Accordingly, Applicants respectfully request that this rejection be withdrawn.

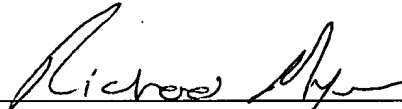
Claim Objections

Applicants note that Claims 44-47 are objected to as being dependent upon a rejected base claim.

From the foregoing, further and favorable reconsideration is requested in the form of a Notice of Allowance and such action is believed to be in order.

If the Examiner has any questions concerning this Response or the Application in general, she is respectfully requested to contact the undersigned at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard S. Myers, Jr.", written over a horizontal line.

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